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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/890,706 | 10/25/2001 | Peter Lauer | 22750/493 | 6149 |

26646 7590 11/20/2002
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| EXAMINER |
| STASHICK, ANTHONY D |

| | |
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| ART UNIT | PAPER NUMBER |
| 3728 | |

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------|-----------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/890,706 | LAUER ET AL. <i>M</i> |
| | Examiner | Art Unit |
| | Anthony D Stashick | 3728 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 11-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 11-26 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 October 2000 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 11.1, 11.2 and 19 as shown in Figure 3. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The abstract of the disclosure is objected to because it contains more than one paragraph. Correction is required. See MPEP § 608.01(b).
3. The claims of the application have been renumbered according to 37 CFR 1.126 and are hereby renumbered as claims 11-26, and referred to by their new numbers below.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 14, 16 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 contains the phrase "as little as possible". It is unclear how little or how much of the torsion between the front and back sections can be influenced. Claim 16 contains the phrase "is a shoe for small children" which renders the claim so. It is unclear as to what is meant to be encompassed by this limitation. What makes a child small, medium, large? Claim 23 contains the

phrase "the thickness being reduced to a minimum thickness required by conditions for manufacturing.". It is unclear as to what is meant to be encompassed by this limitation in the claims. Any sole can meet the minimum conditions for manufacturing depending upon what those conditions are meant to be. Since these conditions are not disclosed, it is difficult to determine what the metes and bounds of the claim is supposed to be.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-14, 16 and 20-24 rejected under 35 U.S.C. 103(a) as being unpatentable over the French reference to Decathlon Production 560,698 (Decathlon '698) in view of Kiyosawa 4,878,301. Decathlon '698 discloses all the limitations substantially as claimed including the following: an outsole 25; an upper (see Figures 1 and 2); the outsole having a contraction (that shown in Figure 3 where the section IV is shown) extending into a first area where the back of the foot is located; a heel guide (heel counter shown in Figures 1 and 2) for the heel provided in the upper part; the heel guide located in a second area where the heel is located; the heel guide is such that the Achilles tendon of the foot is free (heel counter supports the heel bone but not above it as shown); the contraction in the outsole is in a third area between the forefoot and the back of the foot (see Figure 3); the outsole has a connecting area adjacent the contraction (that between the two contractions shown in Figure 3); the connecting area has a flexibility such that a torsion of a forefoot with respect to the back of the foot is impeded as little as possible; the shoe is for small children (children can use the shoe); the contraction is on both the

outside and the inside of the shoe (see Figure 3); the outsole has a thickness that is the thickness being reduced to a minimum thickness required by conditions for manufacturing (the thickness of the sole can meet conditions for manufacturing, otherwise would not be made); the outsole is provided with a heel in the first area (see Figures 1 and 2). Decathlon '698 does not disclose or teach the heel guide having a heel plate. Kiyosawa '301 teaches that a shoe can have a heel counter attached to it to aid in supporting the heel of the user. The heel counter contains a heel plate 1 and 2 which aid in balancing the user's heel. Therefore, it would have been obvious, in view of Kiyosawa '301, to make the heel counter of Decathlon '698 (shown in Figures 1 and 2) out of a hard elastic heel plate, as taught by Kiyosawa '301, to aid in balancing the heel of the user during use to aid in preventing pronation or supination.

8. Claims 15, 17, 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 11 above in view of DuFour 5,024,007. The references as applied to claim 11 above disclose all the limitations of the claims as noted above except for the outsole having a profiling, the profiling for a great flexibility of the outsole with regard to the heel-to-toe motion of the foot; the profiling having one of a parallel grooves and ray-shaped grooves; the grooves extending at least partially over a width of the shoe, and the profiling being made up of at least two materials having different elasticity. DuFour '007 teaches that the forefoot area of the sole of a shoe can have profiling made up of grooves and material filled within the grooves to aid in flexibility and gripping of the sole to the contact surface. DuFour '007 also teaches that the grooves can be parallel (see Figure 1) and extend at least partially over a width of the sole of the shoe and made up of two materials (A and B), the materials having a different elasticity (col. 2, lines 56-68). Therefore, it would have been obvious to make a profile, such as that shown in DuFour '007, on the sole of the references as applied to claim 11 above to aid in making the sole flexible as well as still allowing grip, as taught by DuFour '007.

9. Claims 18 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 17 above in view of the French reference to Scop Minibel Sa Societe Anonyme 2,739,533 (Scop '533). The references as applied to claim 17 above disclose all the limitations of the claims except for the grooves extending over the entire width of the shoe. Scop '533 teaches that grooves 5 made in the forefoot of the shoe sole for flexibility of the sole can extend the entire width of the shoe to allow the sole to flex with the normal flexing of the user's foot. Therefore, it would have been obvious, in view of Scop '533, to make the grooves of the references as applied to claim 17 above cross the entire shoe to aid in flexing the sole with the normal flexing of the user's foot.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Tuesday through Friday from 8:30 am until 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

| | |
|---------------------------------|---------------------|
| Allowed Files & Publication | (703) 305-8322 |
| Assignment Branch | (703) 308-9287 |
| Certificates of Correction | (703) 305-8309 |
| Drawing Corrections/Draftsman | (703) 305-8404/8335 |
| Fee Increase Questions | (703) 305-5125 |
| Intellectual Property Questions | (703) 305-8217 |
| Petitions/Special Programs | (703) 305-9282 |
| Terminal Disclaimers | (703) 305-8408 |
| Informal Fax for 3728 | (703) 308-7769 |

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line 1-800-786-9199
Internet PTO-Home Page <http://www.uspto.gov/>

Altony Starbuck

Anthony D Stashick
Primary Examiner
Art Unit 3728

ADS
November 17, 2002